

USSN 08/666,164
AMENDMENT UNDER 37 C.F.R. § 1.116

Notice of Appeal. The fee for the Notice of Appeal has not included because Applicant previously paid for the appeal fee on November 4, 1998.

In the Office Action, the Examiner denied Applicant's request for continuing-in-part status with respect to Application Nos. 08/649,831 and 08/649,833 because these applications were abandoned at the time of the request. But, both of these applications were abandoned in favor of continuation applications. These applications were filed under the old rules, and thus were assigned different application numbers. Thus, Applicant has amended the specification to update the status of these two applications. In view of the above, the Examiner is respectfully requested to grant Applicant's request for continuing-in-part status for these applications.

Applicant will file a substitute Declaration from the inventors, which reflects the updated status of these applications.

In the Office Action, claims 1, 6-9, 14, 17, 18, 23, 24 and 26-30 were rejected under the doctrine of double-patenting over claims 1-37 of U.S. patent No. 5,737,771. Although not indicated in the Office Action, Applicant believes that a terminal disclaimer will overcome this double-patenting rejection, and is willing to submit same upon an indication that these claims are otherwise allowable. Clarification from the Examiner as to whether a terminal disclaimer will obviate this double-patenting rejection is respectfully requested.

Claims 1, 14, 16-18, 20, 22-24, 26-30, 33 and 54-57 were rejected under 35 USC §102(e) as being anticipated by Palmeri '558 patent. Applicant respectfully traverses this rejection for the following reasons.

Applicant again submits that the Palmeri '558 patent is not prior art to the present application. In repeating this rejection the Office Action states: "See the previous Office Action". Accordingly, the Examiner does not address Applicant's response to this same rejection as found on page 9 of the Amendment filed on November 4, 1998. Specifically, in the November 4, 1998 Amendment, Applicant noted that the Palmeri '558 patent is not prior art to the present application because the date of Applicant's invention is prior to the Palmeri '558 patent filing date. The Examiner's attention is directed to the Fourth Request For Interference filed on August 29, 1997, wherein Applicant submitted Declarations and documentary evidence demonstrating that the date of the present invention is prior to July 27, 1995 — the filing date of the Palmeri '558 patent. Since the Palmeri '558 patent is not prior art to the present application, it is respectfully submitted that the § 102(e) rejection is improper. In view of the foregoing, reconsideration and withdrawal of the §102(e) rejection is respectfully requested.

As discussed with the Examiner, Applicant's undersigned attorney believes that this application should be forwarded to the Board for a declaration of interference. In this regard, pages 1-2 of the March 1, 1999 Office Action states as follows: "[p]rosecution is suspended for claims 58-50 and 53 for consideration of a possible interference based on applicant's First Request for Interference.", and "*Ex Parte* prosecution is suspended in this application for consideration of a possible interference. This application will be forwarded to the Board of Appeals and Interferences." Notwithstanding these statements, the Examiner has taken the position, during the telephone message of July 21, 1999, that Applicant needs to respond to the outstanding Office Action. While Applicant does not agree a Response is necessary, Applicant

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submits the present Amendment. Applicant respectfully submits that this case should be forwarded to the Board for consideration of Applicant's Request for Interference, as indicated in the outstanding Office Action.

Applicant hereby petitions for any extension of time which may be required to maintain the pendency of this case, and any required fee for such extension or any other required government fee, except for the Issue Fee, is to be charged to Deposit Account No. 19-4880.

Respectfully submitted



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